

Appl. No. 10/764,850
Atty. Docket No. CM2587CQ
Amdt. dated March 07, 2006
Reply to Office Action of December 7, 2005
Customer No. 27752

REMARKS

Claim Status

Claims 1 - 14 are pending in the present application. No additional claims fee is believed to be due.

Amendment to the Specification

Applicant has submitted an amended abstract of less than 150 words.

Rejection Under 35 USC §112, First Paragraph

Claims 1-12 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. The Office states:

Claims 1-12 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Present claims 1-5 relate to a product defined by reference to desirable characteristics or properties defined by the use of parameters, namely the saturation capacity, the retention capacity and the intake time for a first insult.

Applicant traverses the rejection.

First, Applicant asserts that the rejection may be in error given the support provided by the Office. The Office states, "Present claims 1-5 relate to a product defined by reference to desirable characteristics or properties defined by the use of parameters, namely the saturation capacity, the retention capacity and the intake time for a first insult." However, Claims 1-5 of the present application do not recite saturation capacity, retention capacity, or intake time for a first insult.

Second, "[t]he test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation." *United States v. Telectronics, Inc.*, 857 F.2d 778, 785 (Fed. Cir. 1988). Applicant asserts that ample description exists in the specification to enable one reasonably skilled in the art to make the invention. In support of this assertion, the Office is directed to page 26, line 5 to page 29, line 30 of the specification describing a preferred article and to page 24, line 10 to page 26, line 3 of the specification describing a preferred process for making an article of the present invention.

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Applicant respectfully requests withdrawal of the rejection in light of the arguments presented.

Rejection Under 35 USC §112, Second Paragraph

Claims 1-12 are rejected under 35 U.S.C. § 112, second paragraph, as failing to being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Office states:

Regarding claims 1-5, claims merely setting forth physical characteristics desired in article, and not setting forth specific compositions which would meet such characteristics, are invalid as vague, indefinite, and functional since they cover any conceivable combination of ingredients either presently existing or which might be discovered in future and which would impart desired characteristics; thus, expression "a liquefiable substance having a liquefaction temperature from about 40°C. to about 300°C. and being compatible with the ingredients in the powdered detergent composition" is too broad and indefinite since it purports to cover everything which will perform the desired functions regardless of its composition, and, in effect, recites compounds by what it is desired that they do rather than what they are; expression also is too broad since it appears to read upon materials that could not possibly be used to accomplish purposes intended. -*Ex parte Slob* (PO BdApp) 157 USPQ 172.

Applicant asserts that the Office's reliance on *Slob* is in error. The Board in *Slob* states, "In our opinion, this language purports to cover everything which will perform the desired *functions* regardless of its composition, and, in effect, recites the compounds by what it is desired that they do rather than what they are." *Ex parte Slob*, 157 USPQ 172 (B.P.A.I. 1967)(emphasis added). However, the Court of Customs and Patent Appeals, in a subsequent case, states, "We take the characterization 'functional' . . . to indicate nothing more than the fact that an attempt is being made to define something . . . by what it does rather than by what it is In our view, there is nothing intrinsically wrong with the use of such a technique in drafting patent claims. Indeed we have even recognized in the past the practical necessity for the use of functional language." *In re Swinehart*, 58 C.C.P.A. 1027, 1030 (C.C.P.A. 1971). Applicant asserts that, in light of *Swinehart*, functional claims are not intrinsically vague or indefinite.

Furthermore, the MPEP § 2173.04 states that breadth of a claim is not to be equated with indefiniteness. While the claims of the present application may be viewed as broad by the Office, Applicant asserts that the claims are definite as written and the

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scope of the claims is clear.

Applicant respectfully requests withdrawal of the rejection in light of the arguments presented.

Rejection Under 35 USC §102

Claims 13 and 14 are rejected under 35 U.S.C. § 102(b) as being anticipated by European Patent Application No. 0 433 951 A2 to Endres et al. (hereafter "Endres"). In support of the rejection, the Office states:

Regarding claim 13, Endre *et al.* teach a wearable absorbent article (10), preferably diaper or pull-on pants, having a back sheet (30) and a topsheet (26) comprising a first waist region (46), a second waist region (44), and a crotch region (24) interposed there between, a longitudinal axis, and an opening (38), which provides a passageway to a primary void space (56) for receiving bodily exudates therein, positioned between the topsheet (26) and the back sheet (30); whereby the opening (38) is positioned in at least the crotch region (24) along the longitudinal axis; whereby the topsheet (26) is elasticated (68).

The Office further states, "Product-by-process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps." The Office concludes, "There are not claimed steps which necessarily lead to a finished article which is materially different from that of the cited reference." Applicant traverses the rejection.

First, Applicant asserts that Endres fails to teach each and every limitation present in Applicant's claims. Claim 13 recites that "the topsheet is elasticated." Applicant states that elasticated means "the topsheet comprises at least a portion made of elastic material, which is elastic in at least the longitudinal direction." Page 5, lines 20-22. The Office suggests that the item (68) is the elasticating member of the topsheet (26). However, Endres states, "Containment flaps 58 include at least one elastic member 66 in each distal edge portion 68." Col. 5, lines 42-44. Even if the Office intended to recite the elastic member (66) as being the elasticating portion of the topsheet, such a teaching is in error since the elastic member (66) is associated with the containment flap (58) and not the topsheet (26).

Second, the Office states, "There are not claimed steps which necessarily lead to a finished article which is materially different from that of the cited reference." Applicant respectfully disagrees with the Office's assertion. Below, Applicant points to several steps in the present application that yield an article different from the one disclosed in

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Endres.

- “applying said elastic material over about the total length of the active part of the first sheet, along the longitudinal axis of the sheet, to form a laminate having the elastic profile as in claim 1” – As presented above, Endres teaches that the elastic member (66) is associated with the containment flap (58) and not the topsheet (26).
- “cutting a slit opening in the first sheet of step a), or in the laminate of step c), along at least part of the longitudinal axis of the sheet” – Applicant fails to find a teaching in Endres of a first sheet (presumably the topsheet (26)) with a slit opening along at least part of the longitudinal axis.

Applicant asserts that the claimed steps will yield a finished article that is materially different from the article presented in Endres.

In light of the arguments presented above, Applicant respectfully requests withdrawal of the rejection.

Claims 1-12 stand rejected under 35 U.S.C. § 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over Endres. In support of the rejection of Claims 1-3, the Office reasserts the Endres teachings as presented above in regard to Claims 13 and 14. The Office concludes, “Given the elastic elements of the reference, it should inherently meet the stretch performance of the claimed invention.” Applicant respectfully traverses the rejection.

First, as presented above, Endres fails to teach each and every limitation present in Applicant’s claims. Claim 1 recites that “the topsheet is elasticated.” Applicant states that elasticated means “the topsheet comprises at least a portion made of elastic material, which is elastic in at least the longitudinal direction.” Page 5, lines 20-22. The Office suggests that the item (68) is the elasticating member of the topsheet (26). However, Endres states, “Containment flaps 58 include at least one elastic member 66 in each distal edge portion 68.” Col. 5, lines 42-44. Even if the Office intended to recite the elastic member (66) as being the elasticating portion of the topsheet, such a teaching is in error since the elastic member (66) is associated with the containment flap (58) and not the topsheet (26).

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Second, the Court of Appeals for the Federal Circuit, in regard to the requirements for an anticipation rejection based on inherency, has stated:

To establish inherency, the extrinsic evidence "must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." "Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient."

In re Robertson, 169 F.3d 743, 745 (Fed. Cir. 1999)(citations omitted). The Office states, "Given the elastic elements of the reference, it should inherently meet the stretch performance of the claimed invention." Applicant contends that a reference that hypothetically "should" meet the claim limitation does not adequately address the Court's standard that the "missing descriptive matter is necessarily present." Applicant contends that a reference that hypothetically should meet the limitations of the present invention is equivalent to a teaching that may or may not meet the limitation. Such a teaching does not meet the threshold for inherency as established by the Court of Appeals for the Federal Circuit.

With regard to the alternate grounds of rejection based on 35 U.S.C. § 103(a), the Office states, "[D]ifferences in ranges of values will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating range of values." Applicant asserts that ample support exists in the specification for the range of values recited in the claims. Furthermore, Endres does not specifically state the load or unload forces exhibited by the elastic member (66) (again, Applicant emphasizes that the elastic member is associated with containment flap (58) and not the topsheet (26)). Additionally, Applicant asserts that evidence of the criticality of the recited load and unload values has been provided in the specification. See page 2, lines 5-20.

With regard to Claims 6-11, these claims are dependent from and include all of the limitations of Claim 1. Since Claim 1 is patentably distinct over Endres, Applicant asserts the Claims 6-11 are likewise patentably distinct over Endres.

In light of the discussion presented above, Applicant respectfully requests withdrawal of the present rejection under 35 U.S.C. §102(b) or, alternatively, under 35 U.S.C. §103(a).

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Rejection Under 35 U.S.C. §103

Claim 12 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Endres in further view of U.S. Patent No. 5,607,760 to Roe (hereafter "Roe"). The Office states, "Roe teaches a diaper having a topsheet with a body lotion for skin comfort. At the time of the invention, it would have been obvious for one of ordinary skill in the art to add the lotion of Roe to the diaper of Endres *et al.* in order to provide a more comfortable topsheet." Applicant traverses the rejection.

Claim 12 is dependent from and contains all the limitations of Claim 1. Endres fails to teach each and every limitation of Claim 1. Roe does not address the deficiencies of Endres in regard to Claim 1. Since Claim 1 is patentably distinct over Endres, Applicant asserts that Claim 12 is likewise patentably distinct over Endres.

In light of the discussion presented above, Applicant respectfully requests withdrawal of the present rejection under 35 U.S.C. §103(a).

Conclusion

This response represents an earnest effort to place the application in proper form and to distinguish the invention as claimed from the cited documents. In light of the above remarks, it is requested that the Examiner reconsider and withdraw the rejection under based on 35 U.S.C. §§ 102(b), 103(a), and 112. Early and favorable action in the case is respectfully requested.

Respectfully submitted,

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By



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